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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,153	11/06/2001	John C.R. Hele	10942-011001	8716
26161	7590	04/10/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 04/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/993,153	Applicant(s) HELE ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 6 November 2001. Claims 1-24 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 1 and 19 recite the limitation "the policy document" in lines 7 and 8, respectively.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 10-15, 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan et al, U.S. Patent Number 5, 655, 085.

(A) As per claim 1, Ryan teaches a machine-based method of providing a user life insurance policy comprising:

determining information required to complete policy documents for a plurality of insurance carriers (Ryan; column 5, lines 3-9, column 23, lines 10-25);

obtaining information from the prospective insured (reads on “a user profile which includes the information”) (Ryan; column 14, line 66 to column 15, line 9);

receiving a selection from the user of an insurance carrier (Ryan; Figure 16, column 5, lines 3-9, column 6, lines 38-47); and

automatically producing an electronic document by entering fields from the user profile into the policy document of the selected insurance carrier (Ryan; Figure 3D-1, Item 276, column 16, lines 31-42, column 23, lines 10-17).

(B) As per claims 2-6, Ryan teaches method as analyzed and discussed in claim 1 above further comprising

“send[ing] the information on the signed forms electronically” (reads on “sending the electronic document to the user over the Internet”) (Ryan; column 6, lines 3-8, 38-57, column 17, lines 1-6); (Examiner interprets Ryan’s teachings of “the system can use front-end network gateways to connect multiple carriers’ computers to the Digital Computer” (Ryan; column 17, lines 1-6) as teaching the Internet);

obtaining a user signature for the electronic document (Ryan; column 6, lines 48-55);

providing the electronic document to the selected insurance carrier (Ryan; column 6, lines 53-57);

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notifying the selected insurance carrier of the policy across the Internet (Ryan; column 6, lines 3-8, 38-57, column 15, lines 47-48, 59-61, column 17, lines 1-6) (Examiner interprets Ryan's teachings of "the system can use front-end network gateways to connect multiple carriers' computers to the Digital Computer" (Ryan; column 17, lines 1-6) together with "Electronic Mail 56 permits electronic communication between system users" (Ryan; column 15, lines 47-48) as teaching notification over the Internet); and

in which at least some of the fields correspond to information obtained from a party other than the user (Ryan; column 5, lines 44-52, column 6, lines 31-77).

(C) As per claims 10-13, Ryan teaches method as analyzed and discussed in claim 1 above further comprising

prior to receiving the user's selection, sending the user a range of pricings for policies from the plurality of insurance carriers (Ryan; Figure 16, column 5, lines 15-24);

prior to receiving the user's selection, sending the user quotes, each quote being a price for a policy from one of the plurality of insurance carriers (Ryan; Figure 16, column 4, line 64 to column 5, line 2, column 5, lines 15-24);

wherein at least part of the user profile is received from a "database" (reads on "partner site that is other than the user") (Ryan; column 6, lines 31-45, column 10, lines 62-66); and

wherein the at least part of the user profile is received from the user in a step-wise process that includes receiving information pertaining to user risk prior to information pertaining to user identity (Ryan; Figure 9, column 17, lines 45-53).

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(D) Claims 14-15 differ from method claims 1, 6 by reciting a “computer readable medium having encoded thereon...” in the preamble. As per this limitation, Ryan clearly discloses his invention to be implemented on a “computer readable medium” (Ryan; column 5, line 44 to column 6, line 20). The remainder of claims 14-15 repeats the limitations of claims 1, 6, and is therefore rejected for the same reasons given above for claims 1, 6.

(E) Claims 19-24 differ from method claims 1, 2-5, 15 by reciting “an article of computer readable medium comprising instructions...” in the preamble. As per this limitation, Ryan clearly discloses his invention to be implemented on a “an article of computer readable medium” (Ryan; column 5, line 44 to column 6, line 20). The remainder of claims 19-24 repeats the limitations of claims 1, 2-5, 15, and is therefore rejected for the same reasons given above for claims 1, 2-5, 15.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-9, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al, U.S. Patent Number 5, 655, 085 as applied to claims 1 and 6 above, and further in view of Forman, U.S. Patent Number 6, 826, 536.

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(A) As per claims 7-9, Ryan teaches a method as analyzed and discussed in claims 1 and 6 above.

Ryan fails to explicitly disclose a method

wherein the party other than the user is a medical examiner;

wherein the party other than the user is a fraud-prevention agency; and

wherein the party other than the user is a government agency.

However, the above features are well-known in the art, as evidenced by Forman.

In particular, Forman teaches

wherein the party other than the user is a medical examiner (Forman; column 4, lines 58-59);

wherein the party other than the user is a fraud-prevention agency (Forman; column 5, lines 61-65); and

wherein the party other than the user is a government agency (Forman; column 4, lines 58-59, column 13, lines 34-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Ryan to include these limitations, as taught by Forman, with the motivations of generating specific user profiles and enabling the insurance company payers to be able to identify fraudulent claims which drive up the cost of health care (Forman; column 4, lines 6-11).

(B) Claims 16-18 differ from method claims 7-9 by reciting a “computer readable medium having encoded thereon...” in the preamble. As per this limitation, Ryan clearly discloses his invention to be implemented on a “computer readable medium” (Ryan; column 5,

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line 44 to column 6, line 20). The remainder of claims 16-18 repeats the limitations of claims 7-9, and is therefore rejected for the same reasons given above for claims 7-9.

The motivations for combining the respective teachings of Ryan and Forman are as given in the rejection of claim 7 above, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Peach, U.S. Patent Application Publication Number 2001/0049611, Felsher, U.S. Patent Application Publication Number 2002/0010679, Mori et al., U.S. Patent Number 6, 070, 148, Walker et al., U.S. Patent Number 6, 119, 093, Barret, et al., U.S. Patent Application Number 2003/0144874, Evans et al., U.S. Patent Application Publication Number 2003/0120557, Moore et al., U.S. Patent Number 5, 930, 759, Lockwood, U.S. Patent Number 4, 567, 359, Pitroda, U.S. Patent Number 5, 590, 038, White et al., U.S. Patent Application Publication Number 2002/0091550 and Dang, U.S. Patent Number 5, 835, 897, teach the environment of online insurance documentation.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

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For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

March 28, 2006


C. LUKE GILLIGAN
PATENT EXAMINER